

Hallenbeck *et al.*
App. No. 09/870,203

REMARKS

The undersigned attorney would first like to express his appreciation for the helpful comments and suggestions provided by Examiners James Housel and Myron Hill during several telephone conversations on Oct. 29-31, 2002. The remarks concerning the Restriction/Election Requirement embody the substance of what was discussed with the Examiners.

The Specification

The continuing data in the first paragraph of page 1 has been updated to provide the provisional application number that was assigned to Application No. 09/585,344 following its conversion to a provisional application. Attached hereto is a marked-up version of the change made to the specification by the current amendment. The attached page is captioned "VERSION WITH MARKINGS TO SHOW CHANGES MADE".

Restriction/Election

As set forth above, Applicant has elected the invention set forth in Group I (claims 1-7 and 33-36) with traversc. Applicant traverses because the inventions claimed in Group I and Group III amount to subcombination and combination inventions, respectively, and are therefore not patentably distinct. Accordingly, Applicant respectfully submits that the claims of Group I and Group III should be examined together in a single group.

MPEP § 806.05(c) sets forth the criteria for distinctness for combinations and subcombinations. In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated. The inventions are distinct if it can be shown that a combination as claimed:

- (A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and
- (B) the subcombination can be shown to have utility either by itself or in other and different relations.

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In The Specification

The paragraph on page 1, lines 4-9, has been replaced with the following rewritten paragraph:

-- This application claims the benefit under 35 USC §119(e) of the following United States provisional applications: (1) Provisional Application No. 60/266,309, [to be assigned,] filed June 2, 2000 [as Application No. 09/585,344, and subject to a Petition for Conversion to Provisional Application filed December 21, 2000;] and (2) Provisional Application No. 60/270,555, filed February 22, 2001. The disclosures of these applications are incorporated herein by reference in their entirety. --

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When these factors cannot be shown, such inventions are not distinct.

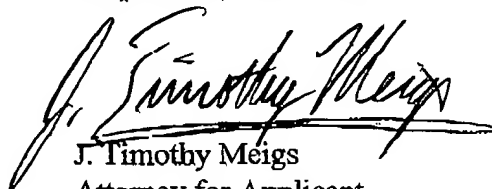
Here, criterion (A) is not met, because the combination of Group III as claimed (adenovirus particle comprising mutated adenoviral fiber protein) does require the particulars of the subcombination of Group I (mutated adenoviral fiber protein) for patentability over the art. Each of the adenovirus particles of Group III is claimed in dependent form as comprising the fiber protein of an earlier claim. If the mutated adenoviral fiber protein is patentable over the prior art, then so is an adenovirus particle comprising such a fiber protein.

Accordingly, Applicant respectfully requests that the claims in Group III be consolidated with the claims in Group I and examined together as a combination/subcombination.

Furthermore, if the Office determines that the claims to the adenovirus particle are allowable over the prior art, then Applicant respectfully requests that the Office rejoin the method claims in Groups IV, V, and IV pursuant to *In re Ochiai*.

No new matter has been added. If in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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